

*et al.* in view of Kindiger *et al.* and further in view of Schnable *et al.* Claims 3 and 14 were rejected as being unpatentable over Lindemann *et al.* in view of Kindiger *et al.* and further in view of Halverson *et al.* Applicants respectfully traverse.

Lindemann *et al.* is cited as teaching a subtractive hybridization method. Kindiger *et al.* is cited as allegedly teaching a primer to the Mu insertion. The Examiner believes that it would have been obvious to modify the subtractive hybridization procedure of Lindemann *et al.* using the "primer" of Kindiger *et al.* to arrive at the claimed invention. Schnable *et al.* is cited as teaching cosegregation analysis. Halverson *et al.* is cited as teaching bulked segregant analysis.

Applicants contend that while individual elements of the claims may arguably be found amongst the cited references, none of the references either alone or in combination provide the requisite motivation to make the claimed invention as mandated by law. The M.P.E.P. at §2143 states,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F. 2d 488, 20 USPQ2d 1438 (Fed Cir. 1991) (emphasis added).

Applicants acknowledge that the motivation or suggestion to combine prior art references need not be explicit. *In re Nilssen*, 7 USPQ2d 1600 (Fed. Cir. 1988). However, an implicit suggestion does not mean a suggestion which is non-existent, unfathomable, or guessed at. The Examiner cannot simply cobble together disparate elements found amongst the prior art and then contend that their mere presence is sufficient motivation to make the claimed invention. A proper rejection for obviousness is not achieved by simply deconstructing Applicants' claimed invention into a collection of elements, searching the prior art for the existence of these elements, and then declaring that motivation to make the

claimed invention exists because it was technically feasible to construct it from this prior art parts list.

Applicants respectfully remind the Examiner that the Federal Circuit has stated that the requisite motivation to make a rejection of the claimed invention under 35 U.S.C. §103 must come from the prior art and not applicant's specification. See, *In re Dow Chem Co. V. American Cyanamid*, 5 USPQ2d at 1531-1532 (Fed. Cir. 1988). Using Applicants' disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate of §103 of judging obviousness at the point in time when the invention was made. In the present Office Action, the Examiner fails to present a line of reasoning as to why the claimed invention would have been obvious from the mere existence of isolated elements available in the prior art. The prior art itself must suggest the desirability of the modification of the prior art. See, *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification".).

The Examiner has used Applicants claimed invention as a starting point for a shopping trip through the prior art. The Examiner, having found the claimed elements scattered about in the literature, takes the position that there is motivation to make Applicants' claimed invention. Why is there motivation? Because, the Examiner contends, Applicants claimed invention is useful. And since there is an incentive to make useful inventions and the isolated elements of the claimed invention existed in the prior art the Examiner thus concludes that Applicants' claimed invention is obvious. Effectively then, Examiner is under the belief that she merely needs to find isolated elements of the claimed invention in the literature to make a *prima facie* case of obviousness. What the Examiner fails to see is that motivation must be provided by the prior art, not Applicants own disclosure. The Federal Circuit has cautioned Examiners from venturing into this "tempting but forbidden zone of hindsight reconstruction". *In re Dembiczaik*, 50 USPQ2d 1614 (Fed. Cir. 1999).

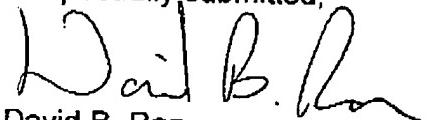
None of the cited references, either in isolation or in combination, suggest that they should be combined in the manner in which the Examiner argues.

Implicit motivation is not properly construed as an absence of motivation neither is it authorization to employ obscure reasoning to infer motivation. The Examiner fails to articulate the logic which would have led one of ordinary skill in the art to make the claimed invention *at the time the invention was made*. Many inventions, and perhaps all, are obvious in retrospect. But this is not the vantage point from which a determination of obviousness must be made. Certainly, Applicants' own disclosure cannot be employed to provide the requisite suggestion or motivation. Since no such motivation existed at the time of Applicants' invention, the law deems that the required element of motivation is absent. Accordingly, Applicants respectfully request that the Examiner reconsider her position and withdraw the improper rejections made under §103.

### CONCLUSION

For the foregoing reasons, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103 and passage of the application to issuance. In the event that any issues of substance remain, Applicants hereby request a telephone interview with the Examiner prior to preparation of any additional written action by the Examiner. Please feel free to call the undersigned to arrange for an Examiner's interview or to discuss the status of the application.

Respectfully submitted,



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